

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application, and for the personal interview conducted on July 29, 2004. The application has been carefully reviewed in light of the Office action and interview, and this amendment is in response thereto.

The examiner objected to claim 1 because of informalities. Claim 1 has been amended to address the Examiner's concerns, making the objection moot.

Claims 1-4, 6-34, 36, 39, 40 & 42 were again rejected under 35 U.S.C. §103(a) as being unpatentable over Shapiro (U.S. 5,705,980) in view of Balachandran (U.S. 6,073,004). Claims 5, 41, 43, and 45 were rejected as above in combination with Alperovich *et al.* (U.S. 6,078,804). Claims 37 & 38 were rejected as being unpatentable over Alperovich in view of Pecan *et al.* (U.S. 6,466,804). For the following reasons, the rejections are respectfully traversed.

Claim 1 recites a method for distributing an emergency call message within a telecommunication network with the steps of "determining a first set comprising one or more terminals" and "determining a second set comprising one or more terminals". Neither of the references suggest determining both a first and second set of terminals as recited in claim 1.

The Examiner argues that first and second sets of terminals are "evidenced by the fact that mobile police/security officers are assigned to and prepositioned within a protected area where they can be summoned in the event of an emergency within that protected area". However, even if true, the first and second set cannot both read on the officers terminals. Claim 1 specifically recites that the terminals of one of said first set and said second set are "mobile devices part of the communication network that are in a vicinity closest to said mobile user" whereas the terminals of the other of the first set and said second set are "terminals predefined by said user". These are mutually exclusive features, and the Examiners referral to the mobile terminals of the officers can only read one of the sets, i.e., "in a vicinity closest to said mobile user". Further, the Examiner admits that Shapiro does not teach terminals "predefined" by the user. Thus, Shapiro cannot teach both a first and a second set as recited in claim 1.

The Examiner points to Balachandran as teaching terminals that are "predefined by the user". But claim 1 also specifically recites that "if no terminal of said first set acknowledges said emergency call, then automatically sending said emergency call message

to said terminals of said second set”. Neither reference can teach such a limitations, because neither reference teaches a first and a second set as defined by the claim. Thus, even if the Examiner were to argue that Shapiro teaches the first set, and Balachandran teaches the second set, it is clear that neither reference teaches “if no terminal of said first set acknowledges said emergency call, then automatically sending said emergency call message to said terminals of said second set”, and thus claim 1 is patentable over the combination of references.

Further, the Examiner has failed to provide the proper motivation for the combination. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has still not cited any support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination. Instead, the Examiner merely argues that the motivation is “found in the knowledge generally available to one of ordinary skill in the art”. This is nothing more than a conclusory statement. The Examiner must provide some rationale for combining the references, and that rationale must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). The Examiner has provided no “convincing line of reasoning” but has instead merely provided a conclusion. Accordingly, the Examiner has failed to support a prima facie case of obviousness, and thus the rejection is improper.

Further, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.01. In this case, the Balachandran reference is activated by sensors that detect an automobile accident, and uses a mobile telephone network. In contrast, Shapiro uses a dedicated network, not a mobile telephone network, and is manually activated. Combining

with Shapiro to attempt to arrive at the invention would change this principle of operation of one or the other references, which is not proper. Thus, the combination is not permitted.

Neither Alperovich nor Pecen overcome the above shortcomings discussed for the claim 1 rejection. Accordingly, claims 2-39, which depend, directly or indirectly, on claim 1, are hence patentable for at least the same reasons as claim 1.

Further, in the prior rejection, the Examiner blanketly stated that many features that are not taught by the references would be “obvious” to add because they provide some benefit, and the Examiner took official notice to that effect. Applicant traversed these assertions, but the Examiner failed to provided the supporting references, as required (see MPEP §2144.03: “If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position”). Further, the Examiner cites various references for teaching various features to support an assertion of “official notice”, without providing any motivation or reasoning for adding those features to the base reference. Applicant does not dispute that the claimed features provide some benefit. The problem is that the Examiner has not shown, sufficient to the required legal standards (i.e., providing proper motivation) that it would be obvious to add these features to the base references. Thus, even if a feature is known for some other use or application, the Examiner must provide some motivation or reasoning for adding that feature to the base references. Thus, the features are not properly combined with the base references absent this required motivation, and thus the combinations are improperly used to reject the claims.

Further still, as previously argued, Claim 40 recites “automatically sending the emergency call message first to one or more **arbitrary** mobile devices in a vicinity closest to the mobile user” and then “distributing the emergency call message to terminals predefined by said user”. Neither reference suggest sending an emergency call message to one or more **arbitrary** mobile devices in a vicinity closest to the mobile user. Shapiro teaches sending messages only to **officers** and uses a dedicated network, not a telecommunication network having arbitrary mobile devices. Thus, Shapiro does not teach sending messages to “arbitrary” mobile devices, which might be to a private citizen closer to the emergency than the closest police officer, for example. Balachandran sends messages to a base station, not a mobile device.

The Examiner responds to the above argument by stating that “the claim language does not exclude police officers from being arbitrary devices” and that “when the emergency

message is sent to the police officers, it is arbitrarily sent to police officers in the vicinity of the user in distress...". However, neither argument is relevant. The Shapiro device does not automatically send the emergency call message "first to one or more arbitrary mobile devices in a vicinity closest to the mobile user" as recited in the claim. Instead, Shapiro teaches only sending the message to the closes officer. Although there may be other devices that are closer to the mobile user, Shapiro will only send the call message to an officer. This is not "arbitrary" but is instead to a specific type of person. In contrast, the invention sends the message to the person closest to the mobile user who has a mobile device on the network, regardless of the type of person. Accordingly, the claim language does not read on Shapiro, and thus Shapiro does not anticipate claim 40.

Consequently, the invention as defined by claim 40 is patentable over the references, even if combined. Alperovich does not overcome the above shortcomings, thus claim 41, which depends on claim 40, is at least patentable over the references for the same reason.

Claim 42 also recites "sending the emergency call message first to one or more arbitrary mobile devices in a vicinity closest to the mobile user" and thus is patentable over the references for the reason discussed for claim 40, above. Alperovich does not overcome the above shortcomings, thus claim 43, which depends on claim 42, is patentable over the references for at least the same reasons as claim 42.

Claim 44 recites "automatically sending the emergency call message first to one or more arbitrary mobile devices part of the communication network that are geographically closest to the mobile user" and then "distributing the emergency call message to terminals predefined by said user". Thus, claim 44 is patentable over the references for the same reasons discussed for claim 40, above. Alperovich does not overcome the above shortcomings, thus claim 45, which depends on claim 44, is patentable over the references for at least the same reasons as claim 44.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

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If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34378.

Respectfully submitted,

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